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APPLICATION NO. 09/652/554 09/652/554	FILING DATE 08/31/00	FIRST NAMED INVENTOR BECK	ATTORNEY DOCKET NO. <i>mlg</i> VOI0154.DIV
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EXAMINER FORTUNA, J

ART UNIT 1731	PAPER NUMBER 5
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DATE MAILED: 04/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/652,554

Applicant(s)
Beck

Examiner
José A. Fortuna

Group Art Unit
1731



☒ Responsive to communication(s) filed on Aug 3, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 8-12 is/are pending in the application.

Of the above, claim(s) 12 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 8-11 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 8-11, drawn to a “method of making paper,” classified in class 162, subclass 202.
 - II. Claim 12, drawn to an “apparatus for making paper,” classified in class 162, subclass 289.
2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process can be used using air presses in the pressurized chamber, i.e., the process does not require the plurality of rollers as indicated by the device claim..
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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5. During a telephone conversation with Jeffrey T Knapp on March 22, 2001 a provisional election was made without traverse to prosecute the invention of group I, claims 8-11.

Affirmation of this election must be made by applicant in replying to this Office action. Claim 12 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 U.S.C. § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 8-11 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The configuration of the pressure chamber, i.e., which is made by the use of rollers in nipping configuration so to form the chamber, critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The specification teaches that the web is formed by depositing a papermaking slurry along the width of a carrying fabric in a pressure chamber is formed by the use of rollers configured to create a fluid tight chamber. This is essential to the claimed invention and therefore, it should be put into the claims.

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Claim Rejections - 35 U.S.C. § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 8-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Grossmann et al., US Patent No. 5,607,555.

Grossmann et al. teach a twin wire system which has all the limitations of the claimed method, i.e., the pressurization chamber is formed by the two endless belts, **01** and **02**, in figure 1, the slurry is deposited/distributed across the width of the carrying fabric, i.e., belt **02**. Since the fabric is part of the pressurized chamber, it reads on the limitation stating "processing said forming fabric through said pressurized chamber." Grossmann et al. teach also the inlet and outlet nips through which the web is passed, see figure 1, pressure devices **II** and **05**. Grossmann et al. also show the provision of a second pressurized chamber, i.e., formed between endless belts **U1** and **U2** to for a second layer or ply.

If the pressure/formation chamber is defined within the scope of the allowed device, then the claims would read over the prior art.

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Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art of "Process of Making Paper."


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to José Fortuna, whose telephone number is (703)305-7498. The examiner can normally be reached on Monday-Friday from 9:30 A.M. to 5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley S. Silverman, can be reached on (703)308-3837. The fax number for this group is (703)305-7115.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-0661.

When filing a FAX in group 1730, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

José A. Fortuna
April 9, 2001


JOSE FORTUNA
PATENT EXAMINER
ART UNIT 1731